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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,428	12/03/2001	Stephen M. Key	PA2321	1741

22830 7590 04/01/2004

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 1/21/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 24-35, 39-51 is/are pending in the application.
- Of the above claim(s) 27-31 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 24-26, 32-35, 39-51 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received
- in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 010603 *(third page)*
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner is including with his action the third page of the IDS filed January 6, 2003 in which he inadvertently failed to enter the date in which the references were considered.

3. Claims 24-26, 32-35 and 39-51 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, applicant has made extensive revisions to the specification at page 7, paragraph 2 and page 8, paragraph 3, and it appears that most, if not all of the revisions may well be new matter. Initially it is noted that the amendments relating to "applying water", "providing static electricity" and "applying a pressure" found on page 7 of the specification clearly lack any express, and it is believed inherent, support in the specification, and applicant has nowhere pointed any such support out with respect to either this or any other revisions. Additionally, the substitution throughout both the specification and the claims of the word "coupling" which is often used alongside "adhering" is believed to possibly be also be new matter, since, as before,

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applicant has nowhere pointed out where any express or inherent support exists, and note also the last sentence set forth on page 8, paragraph 3, as one more additional example thereof.

3. The specification is again objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for the reasons set forth in paragraph No. 3 of Paper No. 0909, together with the following additional observations. Applicant has traversed this objection to the specification, (Response, pages 9-10) but can only supply a single solitary example of what constitutes a "temporary adhesive" and also a "permanent adhesive" which the Examiner respectfully submits is not nearly sufficient to provide proper support for a genus of the breadth that applicant has attempted to both describe and claim. Additionally, as was earlier stated, the specification fails to give any sort of meaningful defining of the boundaries of each of these two genres.

4. Claims 24-26, 32-35 and 39-51 are rejected under 35 U.S.C. § 112, first paragraph as being based upon a defective specification for the reasons set forth above.

5. Claims 24-26, 32-35 and 39-51 are rejected under 35

U.S.C. § 103(a) as being unpatentable over Barnum, Jr., taken either individually, or in view of either of Ingle, Fumei, or Haines. Barnum, Jr. is relied upon as disclosing (note particularly in addition to column 3 lines 4-20, column 1 lines 40-67, column 2 lines 24-26, and column 2 lines 39-53) a container having both an inner label glued or pasted to the container and on the inner label's outer surface an outer label 21 which can be both transparent and also rotatable so as to be capable of viewing the pictures or other printed literature set forth on the outer surface of the inner label. The reference fails to disclose the relatively straightforward bonding arrangements found in applicant's claims, but such claims essentially require only a suitable layer backing coated with either one or two types of adhesive, which is believed within the skill of the art. Alternatively, each of the newly relied upon secondary references are again relied upon substantially as previously set forth in paragraph No. 7 of Paper No. 0909 except for the fact that these labels are not rotatable. However, they clearly teach the relied upon adhesive bonding patterns which have more than one sort of adhesive bonding section, and which the Examiner believes one of ordinary skill in the art is more than capable of designing to fit the required bonding characteristics, including the ability to break a desired bond at

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a certain time so as to enable the outer label to rotate about the inner label or container, which is again substantially all applicant's claims require. Additionally, it is noted that claim 24 does not require the presence of an inner label or container, and that claim 32 essentially requires only the presence of both outer and inner layers, but does not require either labels to be in any sort of bonding relationship, i.e. it essentially appears to be a label kit, and it appears also that independent claim 46, which does require the presence of a container, could also be characterized as a label kit having included among its components a container. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL

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ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status

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information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

March 29, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
1700

Daniel Zinker